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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,721	03/27/2001	Ronald P. Sansone	F-236	1333

919 7590 07/06/2004

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EXAMINER

VU, THONG H

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,721

Applicant(s)

SANSONE ET AL.

Examiner

Thong H Vu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Claims 1-6 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6 are rejected under 35 U.S.C. § 103 as being unpatentable over Chen et al [Chen 5,943,408] in view of Freeman [6,020,980].

3. As per claim 1, Chen discloses a method that enables a recipient to inform a carrier (i.e.: a Web server, an Internet service provider) of the manner in which the recipient would like the mail delivered [Chen, a system provides the subscribers with the freedom to access services providers of their choices, abstract], said method comprises the steps of:

depositing with the carrier mail (i.e.: signaling message) containing the recipient's name and physical address and the sender's name and address;

capturing the name and physical address of the recipient and the sender [Chen, storing the phone number of calling parties and retrieving the number, col 9 lines 24-32; the service expands the alias (name) into the full number, col 10 lines 4-12];

notifying the recipient of the availability of the deposited mail [Chen, the called party notifies the call server directly when an incoming call arrives, col 7 lines 12-21];

notifying the carrier of the manner in which the recipient would like the mail

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delivered [Chen, notation x!y indicates that message y is being received by entity x, col 8 lines 1-12];

notifying the carrier that the sender does not elect the deposited mail to be diverted [Chen, the call server receives notification and transitions into the active state, col 9 lines 1-11]; and

delivering mail to the recipient in the manner specified by the recipient to the carrier, if the sender elects to permit the recipient to divert the mail [Chen, each input event caused by the user, the call server perform certain processing, col 7 lines 56-64].

Chen also discloses a logic translates a code to the number of called party [Chen, col 10 lines 13-23]. However Chen does not detail translating the name and physical address of the recipient into an e-mail address.

It was well-known in the email art that a telephone number or user/domain name could be translated to email address [see Freeman, Cooper references].

An Official Notice is taken that the method for sending a secure email, certified email [Zhou, Mislovew, Deng references]; user selects email message type [O'Neal reference]; server allows the user control resources [Ezerzer, Tsuji, Bodnar, Wakasugi references] were well-known in the art.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the technique of translate a code or telephone number with name or alias into an email address as taught by Freeman [Freeman, abstract]. Doing so would provide a dynamic and efficiency to access to Internet.

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4. As per claim 2, Chen-Freeman disclose the sender places an indication on the mail specifying that the mail should not be diverted by the recipient [Chen, the call server request connection service eliminated the need for switch to execute a state machine to check for service logic trigger, col 6 lines 51-65].

5. As per claim 3, Chen-Freeman disclose charging the sender for placing an indication on the mail specifying that the mail should not be diverted by the recipient [Chen, the call server receives notification and transitions into the active state, col 9 lines 1-11].

6. As per claim 4, Chen-Freeman disclose the sender places an indication on the mail specifying that the mail should be delivered only as specified by the sender [Chen, each input event caused by the user, the call server perform certain processing, col 7 lines 56-64].

7. As per claim 5, Chen-Freeman disclose charging the sender for placing an indication on the mail specifying that the mail should be delivered only as specified by the sender [Chen, each input event caused by the user, the call server perform certain processing, col 7 lines 56-64].

8. As per claim 6, Chen-Freeman disclose the recipient notifies a data center who notifies the carrier of the manner in which the recipient would like the mail delivered

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[Chen, notation x!y indicates that message y is being received by entity x, col 8 lines 1-12].

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (703)-305-4643.

The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Jack Harvey*, can be reached at (703) 305-9705.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9700.

Any response to this action should be mailed to: Commissioner of Patent and Trademarks, Washington, D.C. 20231 or faxed to :

After Final (703) 746-7238

Official: (703) 746-7239

Non-Official (703) 746-7240

Hand-delivered responses should be brought to Crystal Park 11,2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Thong Vu
Patent Examiner
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